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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,339	08/01/2003	Thomas Richards	08935-294001 / M-5029	4181
26161	7590	07/17/2007		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER ECHELMeyer, ALIX ELIZABETH	
			ART UNIT 1745	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/633,339	RICHARDS ET AL.	
	Examiner	Art Unit	
	Alix Elizabeth Echelmeyer	1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13, 15, 51, 59-70, 83-85, 87 and 89.
Claim(s) withdrawn from consideration: 14, 71-82, 86 and 88.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because: the arguments were not found to be convincing. The examiner appreciates Applicants' acknowledgment of her typographical error, on page 10, the first of the Remarks section, concerning the rejection of claim 11 over Johnson in view of Brotz. However, the Brotz reference refers to all calims concerning the concave-convex shape change.

The following remarks are made to follow the order in which arguments were present in the Remarks.

Applicants contend, in the first two pages of the remarks, that the actuator of Johnson changes length, and that a change in length is not a change in shape. The examiner disagrees. The shape memory alloy wires of Johnson, as stated in the fourth paragrph of the second page of the remarks, lengthen or contract. Lengthening and contracting are changes in shape.

Applicants also argue that the mechanism of Johnson includes a bistable latch, making the invention of Johnson more complicated than the instant invention. The examiner believes that the wires of Johnson teach the instantly claimed invention, since the wires (e.g. 90 in Figure 1) change shape to move the cylinders into and out of registration (col 3 ln 1-11). Regardless the extra parts of Johnson, the wires teach a mechanism to move a first member, as required by the claims.

Next, Applicants argue that motivation is lacking to replace the wires, described above, with the actuator of Brotz. Motivation is provided on page 5 of the Final Rejection, mailed April 5, 2007. That motivation includes eliminating the need for both the latch and actuator mechanism of Johnson, resulting in a cell with fewer parts.

Applicants argue that Johnson fails to teach that the actuator only draws power during a change of state. This would be inherent, since if the shape memory alloy actuator of Johnson was drawing power, it would inherently be changing state, so if it is not changing state it cannot be drawing power.

Applicants argue that Johnson does not teach a member between the actuator and the first/second member. The examiner points Applicants to Figures 5 and 6. The actuator mechansim, 29, is attached to the inner member of the can by a rod.

The arguments concerning claims 9-11 state that there is no motivation to combine Johnson with Brotz since the mechanism of Johnson "is more complicated than the examiner acknowledges" (p. 14). As discussed above, the teachings of Johnson meet the limitations of the instant invention. It does not matter what other mechanisms Johnson uses, such as the bistable latch, since the claims do not require that the invention only includes the battery can, first and second members, and a mechansim, such as in claim 1, because the claim is to "a battery compris[ing]" ... The claims are being given their broadest reasonable interpretation, and "comprising" is a non-limiting term (MPEP 2111.03).

Continuation of 13. Other: The amendments to claims 51 and 83 raise new issues that were not included in previous versions of the claims.

Amey Tsang Ts'ao
Supervisory Patent Examiner